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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,796	05/14/2002	Stanley M. Josephson		2713

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EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/063,796	<b>Applicant(s)</b> JOSEPHSON ET AL.	
	<b>Examiner</b> Ahshik Kim	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed on May 5, 2004. In the amendment  
5 claims 1, and 3-19 were amended; and claim 20 was newly added. Currently, claims 1, and 3-20  
remain for examination.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
10 obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the  
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various  
claims was commonly owned at the time any inventions covered therein were made absent any  
20 evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out  
the inventor and invention dates of each claim that was not commonly owned at the time a later  
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)  
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 1, 3-5, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
25 McWhorter (US 5,371,798, hereinafter "McWhorter") in view of Brikho (US 6,592,029,  
hereinafter "Brikho").

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McWhorter teaches a system and method for reducing fraudulent transaction involving financial transaction document such as a check (see abstract). As one measure of thwarting such fraud, McWhorter discloses printing payee picture on the document (col. 1, lines 55+).

McWhorter fails to specifically teach or fairly suggest that payee's picture resides in the  
5 central computer, and it is retrieved for printing and also for verification purpose (i.e., when payee tries to deposit or cash the check).

Brikho teaches a check cashing system (see abstract) wherein customer information including photographic image is entered into a database (col. 1, lines 58+), and when a customer tries to cash a check, photographic record is retrieved for verification (col. 5, lines 26+; col. 6,  
10 lines 42+).

In view of Brikho's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known database and other I/T infrastructure to the teachings of McWhorter in order to use the data for various authentication embodiments. Moreover, by saving image file of a user, his/her image can be repeatedly used in printing checks  
15 or recalled at any retailers and other places for verifying authentication. Although not explicitly suggested in McWhorter, bank relies on existing customer record (or database) in printing additional checks for the existing customers.

5. Claim 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McWhorter (US 5,371,798) as modified by Brikho (US 6,592,029) as applied to claim 1 above, and further in  
20 view of Hayoshi (US 6,611,598, hereinafter "Hayoshi"). The teachings of McWhorter as modified by Brikho have been discussed above.

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McWhorter/Brikho fail to specifically teach or fairly suggest the negotiable instrument further comprises a barcode or other machine-readable code containing payee information.

Hayoshi teaches a negotiable instrument (See abstract; figure 1) comprising a barcode containing payee information (col. 4, lines 36-41). Hayoshi further discloses use of MICR or  
5 other optical characters (OCR) (col. 5, lines 22+).

In view of Hayoshi's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known barcode (1-D or 2-D) to the teachings of McWhorter/Brikho in order to increase data which can be carried on a negotiable instrument. Information contained in barcode can readily be read and used by the barcode reader. Moreover,  
10 the code not legible to humans can conceal sensitive information on the check, and therefore an obvious expedient.

### ***Response to Arguments***

15 6. Applicant's arguments filed on May 5, 2004 have been carefully considered, but it is the Examiner's view that the cited references still teach on the claimed invention disclosed in the instant application.

As indicated in paragraph 4 above, McWhorter discloses a negotiable instrument containing payee's picture. McWhorter's system, although not explicitly, includes computers to  
20 perform magnetic scan, optical scan, printing, etc. etc. Accordingly, the Brikho reference is relied on primarily cure the deficiencies of computer storing and recalling identification information for comparison and verification purposes.

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Applicant further argues, "Brikho, however, not only fails to disclose using the information affixed to the negotiable instrument for verification purposes, but it fails to teach any type of system .....". (See remarks page 15, 2<sup>nd</sup> paragraph). Examiner directs the Applicant that McWhorter discloses a negotiable instrument comprising payee information.

5 In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Moreover, the examiner respectfully submits to the Applicant that "It is not necessary that the reference actually suggest,  
10 expressly or in so many words, changes or possible improvements. All that is required is that the invention was made by applying knowledge clearly present in the prior art." *In re Scheckler*, 58 CCPA 936, 438F. 2d 999, 168 USPQ 716 (1971).

15  
***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE  
20 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahshik Kim whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday. The fax number directly to the Examiner is (571)273-2393.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Patent Examiner  
Art Unit 2876  
July 19, 2004



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